

R E M A R K S

The Official Action of December 21, 2001 (received December 31, 2001) has been carefully considered.

Referring first to paragraph 2 on page 2 of the Action, the misspelling of the word "substantially" in line 11 of claim 1 is regretted; this error has been corrected.

If the Examiner objects to the use of the term "substantially", applicant respectfully invites attention to the decision by the CAFC in *In re Hauserman Inc.* (15 USPQ2d 1157) wherein it was held that

"Words such as 'substantially', 'approximately,' and 'about' are often used in claims to prevent potential infringer from avoiding literal infringement simply by making minor modifications."

As concerns the word "normal", please refer to Webster's Third New International Dictionary where the very first definition of this term states as follows: "forming a right angle".

As far as the antecedent for the term "direction" is concerned, please refer to lines 6-8 of the original claim 1 wherein it is stated that the elongated member of the tool (such as 11) extends "in a direction at least substantially normal to said predetermined axis (A)". Furthermore, this is believed to be plainly shown in numerous Figures of applicant's drawing. For example, in

Fig. 1, the axis A is vertical and the first section of the elongated member of the tool 11 is horizontal, i.e., it is normal to the axis A.

As concerns the rejection of claim 16 as being indefinite, please refer again to Webster's Dictionary wherein the term "trapeziform" is explained as "having the form of a trapezium" and the term "trapezium" is stated to be synonymous with "trapezoid" which, according to Webster, denotes "a quadrilateral having only two sides parallel". Please refer to any one of Figs. 3, 8, 9-11 and 12 each of which shows that the member (17 in Fig. 3, 17' in Fig. 8, etc.) has a trapeziform or trapezium-shaped outline because only two of its sides are parallel.

The rejection of claims 1-3, 6, 9-11, 15, 16, 18 and 19 as being anticipated by the disclosure in US patent No. 3,530,577 to Franklin et al. (hereinafter Franklin) is believed to warrant careful reconsideration. It appears that the Examiner overlooked the statement that the second section of the tool (such as the tool 11) has "at least one at least substantially straight cutting edge" which is at least substantially normal to the aforescussed direction. The terminology "at least substantially straight cutting edge" has been utilized by applicant for the specific purpose of avoiding the

use of the term "cutting edge" without any further interpretation. The reason is that, when used alone, the term "cutting edge" can also denote "cutting point". However, nobody looking at Figures 1, 3 and 14 of the drawing in the patent to Franklin can interpret the two cutting points at 207 or 119 or 121 as even remotely resembling a straight or substantially straight cutting edge. In order to establish the presence of a "straight cutting edge" one must provide the presence of more than two discrete cutting points all of which contact a straight line or which are close to such line. Attention is again respectfully invited to Webster's Dictionary wherein the term "straight" is defined (as a very first interpretation) as follows: "constituting a one-dimensional continuum that is determined throughout its length by any two points included in it". This evidently does not apply for the tool which is disclosed by Franklin because each of the two tools shown in Figs. 1, 3 and 14 of the patent discloses a tool (17 or 203) having only two teeth (points). Applicant respectfully submits that it is simply impossible to stretch the meaning of the terminology "at least one at least substantially straight cutting edge" which is utilized in the two independent claims 1 and 18 of the present application to an extent which would warrant the use of such language to cover the tool which is disclosed by Franklin, i.e., a tool wherein

the cutting part consists of two greatly spaced apart tooth tips.

It is well settled that the Patent Office can rely on 35 USC § 102 only if each and every element of a pending US claim is to be found in or is disclosed by a single reference. Please refer, for example, to the decision which was rendered in the year 2000 by the CAFC in *Apple Computer, Inc. v. Articulate Systems, Inc.* (reported in 57 USPQ2d 1057) wherein it was held as follows:

"Anticipation under 35 USC § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention."

Applicant respectfully submits that the recitation of a tool having an elongated member with a first section and a second section which latter includes at least one at least substantially straight cutting edge constitutes an important distinctive feature which is plainly lacking in the specification and/or in the drawing and/or in the claims of the Franklin reference.

Please refer also to the 1999 decision by the CAFC in *Oney v. Ratliff* (51 USPQ2d 1697) wherein the Court held as follows:

"Invalidity based on lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee."

Applicant believes that the rejection of claims 2, 3, 6, 9-11, 15 and 16 as well as of claim 19, all as being anticipated by Franklin, need not be discussed at this time because these claims depend from the independent claim 1 or 18, i.e., from claims which applicant and his attorney sincerely believe to patentably distinguish over Franklin under 35 USC § 102 as well as under 35 USC § 103.

Applicant further believes that the rejection of claims 4, 5, 7 and 8 need not be discussed at this stage of the prosecution because all of these claims depend from the presumably allowable amended claim 1.

The indicated allowability of the claims 12-14, 17 and 20 is gratefully acknowledged. It is believed here that these claims need not be presented in independent form because they depend from the presumably allowable claim 1 (namely the claims 12-14 and 17) or from the presumably allowable independent claim 18.

The prior art made of record but not relied upon is believed to be less relevant than the art on which the Examiner relied in paragraphs 5, 7 and 8 of the Action.

The enclosed Appendix contains a marked up version of the amended claim 1.

A favorable Action on the merits of the claims 1 through 20 at a reasonably early date is earnestly so-

licated.


It is respectfully requested that all further communications in the above-referenced application be addressed and forwarded to applicant's domestic attorney (Patentanwalt Hans Rudolf Gachnang, European Patent Attorney) whose office address is

Badstrasse 5
CH-8501 Frauenfeld 1
Switzerland.

The reason is the age of the undersigned attorney. Such change of representative is believed to be authorized by the provisions of 37 CFR 1.33 (please refer also to page 400 - 8 of seventh edition of the M.P.E.P.

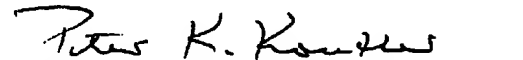
Dated: March 11, 2002

Respectfully submitted,


Peter K. Kontler
Reg. No. 20,384

Encl.

I herewith confirm that this amendment was sent to the US Patent and Trademark Office by facsimile on March 11, 2002 (to the facsimile No. 703 872 9302 which was furnished by the Receptionist of Art Unit 3723 per telephone on March 11, 2002).


Peter K. Kontler
Reg.No.20,384
Address: 4401 Gulf Shore Blvd. North
Naples, FL 34103-3450
Phone: (941) 262-8492
Fax: (941) 434-6747

APPENDIX to Amendment in re application Serial No.
09/917,998 filed July 30, 2001 by Marco STEIGER et al.
for "MATERIAL REMOVING TOOL"
Art Unit 3723
Examiner Ms. Shantese L. McDonald

The following is a marked up version of the amended
claim 1 as it appears in the enclosed Amendment filed
in response to the Official Action of December 21, 2001:

- 1 1. A tool for use with a manually operable mate-
2 rial removing apparatus having a power driven output
3 shaft arranged to oscillate about a predetermined axis,
4 comprising:
5 an elongated member having a first section arran-
6 ged to be mounted on said output shaft so that the member
7 extends in a direction at least substantially normal to
8 said predetermined axis, and
9 a second section remote from said first section
10 and including at least one at least substantially
11 straight cutting edge at least [sbstantially] substanti-
12 ally normal to said direction.